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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,157	01/19/2006	Wittich Kaule	2732-173	7236
6449	7590	10/16/2009		EXAMINER
ROTHWELL, FIGG, ERNST & MANBECK, P.C.				CALLAWAY, JADE R
1425 K STREET, N.W.				
SUITE 800			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20005			2872	
			NOTIFICATION DATE	DELIVERY MODE
			10/16/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/565,157	KAULE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JADE R. CALLAWAY	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 16 July 2009.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-5,9-12,39,48,59,62,63 and 76 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-5,9-12,39,48,59,62,63 and 76 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 19 January 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendments to the claims and the title of the invention, in the submission dated 7/16/09, are acknowledged and accepted.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-5, 9-12, 39, 48, 59, 62, 63 and 76 have been considered but are moot in view of the new ground(s) of rejection.

3. Applicant's arguments, see pages 8-11, filed 7/16/09, with respect to the 35 U.S.C. 112 have been fully considered and are persuasive in light of the amendments to the claims in the instant submission. The 35 U.S.C. 112 rejection of the claims has been withdrawn.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 9, 12, 39, 48 and 76 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmitz et al. (6,491,324).

Consider claims 1 and 76, Schmitz et al. disclose (e.g. figure 8) a security element, which has at least one area with a diffraction structure (13, lacquer layer) embossed during an embossing process with an embossing die, which under specific viewing conditions reconstructs a diffractive image, wherein the area has subareas (10,

gaps) being free of any diffraction structures, the subareas do not take part in the reconstruction of the diffractive image, and represent a recognizable information (characters or patterns), wherein the subareas and the diffraction structure surrounding the subareas have the same or at least very similar reflecting properties under viewing conditions, under which the diffraction structure does not represent a diffractive image, so that the recognizable information represented by the subareas is recognizable substantially only under the specific viewing conditions of the diffractive image (i.e. under transmitted light) and wherein at least one of the subareas is produced during the embossing process with the embossing die already providing the at least one of the subareas being free of any diffraction structure (the embossed layer can be formed separately or directly onto the surface of the carrier) [col. 6, line 10 to col. 7, line 9, col. 8, lines 7-44].

The preceding claim is a product-by-process claim and even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process; see **In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)**.

Consider claim 2, Schmitz et al. teach (e.g. figure 8) a security element characterized in that the area has a first reflection layer (14, reflecting layer), which supports the reconstruction of the diffractive image [col. 6, line 10 to col. 7, line 9].

Consider claim 3, Schmitz et al. teach (e.g. figure 8) a security element characterized in that the at least one subarea does not have a diffraction structure, and that the first reflection layer is disposed in both the area of the diffraction structure and the area of the subareas (layer 14 extends over both elements) [col. 6, line 10 to col. 7, line 9].

Consider claim 9, Schmitz et al. teach (e.g. figure 8) a security element, which has at least one area with a diffraction structure (13, lacquer layer) embossed during an embossing process with an embossing die, which under specific viewing conditions reconstructs a diffractive image, wherein the area has subareas (10, gaps) being free of any diffraction structures, the subareas do not take part in the reconstruction of the diffractive image and represent a recognizable information (characters or patterns), wherein the subareas do not form a diffractive contrast image, so that the recognizable information represented by the subareas is recognizable under viewing conditions differing from the specific viewing conditions of the diffractive image (the information represented by the subareas is only recognizable under transmitted light whereas the information represented by the diffractive image is recognizable under semitransparent light, i.e. the information can be selectively viewable depending on which spectrum of light is used) and wherein at least one of the subareas is produced during the embossing process with the embossing die already providing the at least one of the subareas being free of any diffraction structure (the embossed layer can be formed into a separately or directly onto the surface of the carrier) [col. 6 line 10 to col. 7, line 9, col. 8, lines 7-44].

The preceding claim is a product-by-process claim and even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process; see **In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)**.

Consider claim 12, Schmitz et al. disclose (e.g. figure 8) a security element characterized in that the area is disposed on a transparent carrier (4, transparent carrier), so that the information represented by the subareas is recognizable in transmitted light [col. 6, lines 51-65].

Consider claim 39, Schmitz et al. teach (e.g. figure 8) a method for producing a security element, comprising: embossing during an embossing process with an embossing die at least one area with a diffractive structure, which under specific viewing conditions reconstructs a diffractive image, producing subareas (10, gaps) of the area which do not take part in the reconstruction of the diffractive image, represents a recognizable information (characters or patterns), and are integrated in the area with the diffraction structure such that the subareas and the diffraction structure surrounding the subareas have the same or at least very similar reflecting properties under viewing conditions, under which the diffraction structure does not represent a diffractive image, so that the recognizable information represented by the subareas is recognizable mainly only under the specific viewing conditions of the diffractive image, wherein at least one

of the subareas is produced during the embossing process with the embossing die already providing the at least one subarea being free of any diffraction structures (the embossed layer can be formed separately or directly onto the surface of the carrier) [col. 6, line 10 to col. 7, line 9, col. 8, lines 7-44].

Consider claim 48, Schmitz et al. teach (e.g. figure 8) a method for producing a security element, comprising embossing during an embossing process with an embossing die at least one area with a diffraction structure, which under specific viewing conditions reconstructs a diffractive image, producing subareas (gaps) of the area which do not take part in the reconstruction of the diffractive image, represents a recognizable information (characters or patterns), and are integrated in the area with the diffraction structure such that the subareas form a not diffractive contrast image, so that the recognizable information represented by the subareas is recognizable under viewing conditions differing from the specific viewing conditions of the diffractive image, (the information represented by the subareas is only recognizable under transmitted light whereas the information represented by the diffractive image is recognizable under semitransparent light, i.e. the information can be selectively viewable depending on which spectrum of light is used) and wherein at least one of the subareas is produced during the embossing process with the embossing die already providing the at least one of the subareas being free of any diffraction structure (the embossed layer can be formed separately or directly onto the surface of the carrier) [col. 6 line 10 to col. 7, line 9, col. 8, lines 7-44].

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-5, 10-11, 59, 62 and 63 rejected under 35 U.S.C. 103(a) as being unpatentable over Schmitz et al. (6,491,324) in view of Phillips et al. (2004/0101676).

Consider claim 4-5, and 10, Schmitz et al. disclose (e.g. figure 8) a security element characterized in that the area has a transparent plastic layer (13, transparent lacquer layer), in which the diffraction structure is present in the form of a relief structure, that the first reflection layer (14, reflecting layer) is disposed on the surface of the plastic layer which is provided with the diffraction structure, and that the opposite surface of the plastic layer has a second layer (magnetic layer), wherein the subareas are formed by gaps (i.e. the subareas are formed or are visible due to the semitransparent first reflection layer) in the first reflection layer [col. 6, line 10 to col. 7, line 9]. However, Schmitz et al. does not disclose that the first and second reflecting layers are made of materials having substantially the same reflecting properties. Schmitz et al. and Phillips et al. are related as security devices. Phillips et al. teach (e.g. figure 1) a security device wherein a first reflection layer (18, semi-opaque absorber layer) and a second reflection layer (22, reflector layer) are both made of reflective aluminum [0063, 0068]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the device of Schmitz et al.,

as taught by Phillips et al., in order to create security articles that have a color shifting pattern or an optically variable background to increase the security of the articles.

Consider claims 11 and 62, the modified Schmitz et al. reference discloses (e.g. figure 1 of Phillips et al.) a security element characterized in that the opposite surface of the plastic layer has a second reflection layer (22, reflector layer of Phillips et al.), wherein the first and second reflection layers are made of differently-colored materials (layer 18 can have a grayish color and layer 22 can be made of a variety of materials depending on the color effects desired) [0063, 0068 of Phillips et al.].

Consider claim 59 and 63, the modified Schmitz et al. reference discloses that the materials can both be made of aluminum [0063, 0068 of Phillips et al.].

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JADE R. CALLAWAY whose telephone number is (571)272-8199. The examiner can normally be reached on Monday to Friday 6:00 am - 3:30 pm est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on 571-272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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